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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/664,213 | 09/16/2003 | Hassan Mostafavi | 005513P021 | 3361 |
| 7590 Daniel E. Ovanezian BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1026 | | EXAMINER CWERN, JONATHAN | | |
| | | ART UNIT 3737 | | |
| | | MAIL DATE 03/04/2008 | | |
| | | DELIVERY MODE PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/664,213

Applicant(s)

MOSTAFAVI ET AL.

Examiner

Jonathan G. Cwern

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-61 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16 and 49-58, drawn to method and system for imaging markers and determining coordinates relative to a beam isocenter, classified in class 600, subclass 426.
- II. Claims 17-20 and 59-60, drawn to a method for adjusting a position of a volume within a body relative to a treatment beam using a plurality of markers, classified in class 600, subclass 427.
- III. Claims 21-27, drawn to image processing of an image involving a median filter, classified in class 382, subclass 128.
- IV. Claims 28-30, drawn to image processing of an image involving a 2D size and shape consistency test and a 3D geometric consistency test, classified in class 382, subclass 128.
- V. Claims 31-41, 46-48, and 61, drawn to a method of imaging markers in the body and adjusting the body and treatment beam based on a rigidity of the target and the number of visible markers, classified in class 600, subclass 427.
- VI. Claims 42-45, drawn to a method of imaging markers in the body and estimating the number of positioning images needed for a treatment

session based on the rigidity of the target and the number of visible markers, classified in class 600, subclass 427.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-VI are directed to related products/processes. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed differ in that Invention II requires a treatment beam and involves adjusting a position of a volume within the body, Invention III is directed towards image processing of an image involving a median filter, Invention IV is directed towards image processing of an image involving a 2D size and shape consistency test and a 3D geometric consistency test, that Invention V requires a treatment beam and estimates an adjustment to the body and treatment beam based on the rigidity of the target and the number of visible markers in the image, Invention VI requires a treatment beam and estimates a number of positioning images needed for treatment based on the rigidity of the target and the number of visible markers in the image, while Invention I is directed towards the imaging of the markers and determining coordinates of the markers, using two imaging modalities, and determining the coordinates based on the beam isocenters. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Inventions II and III-VI are directed to related products/processes. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed differ in that Invention III is directed towards image processing of an image involving a median filter, Invention IV is directed towards image processing of an image involving a 2D size and shape consistency test and a 3D geometric consistency test, that Invention V requires a treatment beam and estimates an adjustment to the body and treatment beam based on the rigidity of the target and the number of visible markers in the image, Invention VI requires a treatment beam and estimates a number of positioning images needed for treatment based on the rigidity of the target and the number of visible markers in the image, while Invention II requires a treatment beam and involves adjusting a position of a volume within the body. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Inventions III and IV-VI are directed to related products/processes. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed differ in Invention IV is directed towards image

processing of an image involving a 2D size and shape consistency test and a 3D geometric consistency test, that Invention V requires a treatment beam and estimates an adjustment to the body and treatment beam based on the rigidity of the target and the number of visible markers in the image, Invention VI requires a treatment beam and estimates a number of positioning images needed for treatment based on the rigidity of the target and the number of visible markers in the image, while Invention III is directed towards image processing of an image involving a median filter. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Inventions IV and V-VI are directed to related products/processes. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed differ in that Invention V requires a treatment beam and estimates an adjustment to the body and treatment beam based on the rigidity of the target and the number of visible markers in the image, Invention VI requires a treatment beam and estimates a number of positioning images needed for treatment based on the rigidity of the target and the number of visible markers in the image, while Invention IV is directed towards image processing of an image involving a 2D size and shape consistency test and a 3D geometric consistency test. Furthermore, the inventions as

claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Inventions V and VI are directed to related processes. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed differ in that Invention VI requires a treatment beam and estimates a number of positioning images needed for treatment based on the rigidity of the target and the number of visible markers in the image, while that Invention V requires a treatment beam and estimates an adjustment to the body and treatment beam based on the rigidity of the target and the number of visible markers in the image. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Cwern whose telephone number is (571)270-1560. The examiner can normally be reached on Monday through Friday 9:30AM - 6:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. G. C./
Examiner, Art Unit 3737

/Ruth S. Smith/
Primary Examiner, Art Unit 3737